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IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1942

No. 568.

**THE CONSOLIDATED EXPANDED METAL
COMPANIES,**

Petitioner,

vs.

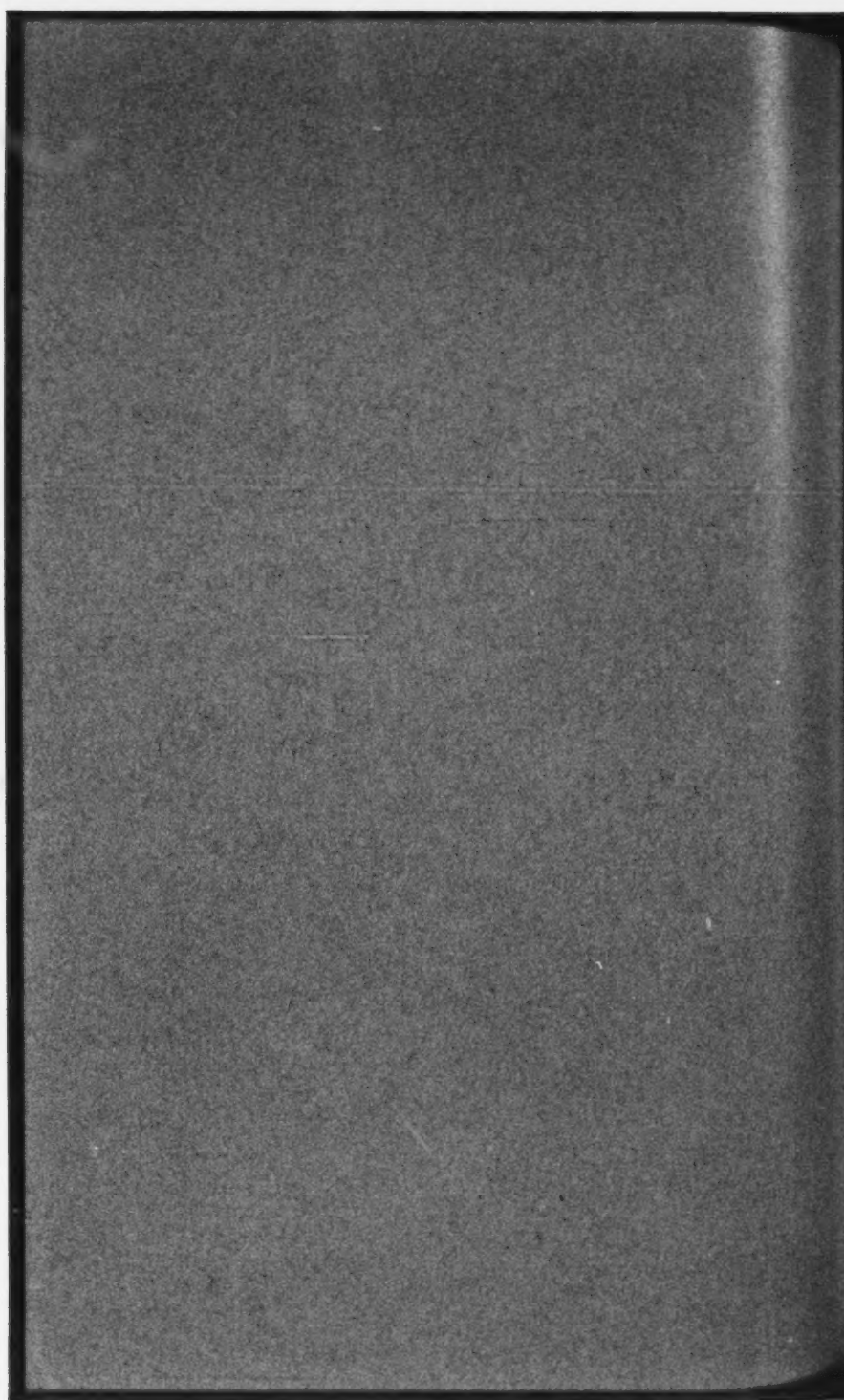
UNITED STATES GYPSUM COMPANY,
Respondent.

**BRIEF FOR RESPONDENT IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI.**

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Foreword.

The petition in this case seeks review of a decision of the Circuit Court of Appeals for the Sixth Circuit, by Simons, J., holding all of the patent claims in suit invalid for want of invention over prior art, knowledge and uses.

No conflict with decisions in other cases exists and no important question of law is involved. The only issue is that of invention, which has been determined upon proper and careful consideration of the evidence. It is significant that petitioner did not apply for a rehearing in the Court of Appeals.

Counter Statement of Facts.

Since the essential facts of the case are considerably obscured and distorted in the petition, a more accurate and informative statement is believed to be in order.

It is true that expanded metal is a very old and well-known material of commerce. It is made in different ways (not universally by the "Golding" process as asserted in the petition, p. 2), but some type of shearing operation is always involved, which inherently produces burrs and sharp edges along the slits or cut portions (Cross patent, Rec. p. 11, lines 7-20). These burrs and sharp edges are no different, however, from those produced by the shearing of any metal sheet or the like (Rec. pp. 77, 921-2). The product takes its form from the distention of the openings cut therein, either as a part of the same operation or as a result of a subsequent operation, this form constituting an open meshwork having several times the area of the original plain metal sheet. Naturally the burrs and sharp edges remain in the expanded product along the lines where the original metal sheet was slitted or otherwise cut.

The Cross patent in suit purports to cover the removal of such burrs and sharp edges by the application of wire brushes to the open meshwork sheets. The petition states (p. 3) that the brushes are applied "in a novel way," but it does not explain anything novel about the operation. Actually, the brushes are applied in the only conceivable way of applying them, that is, by bringing them to bear against the meshwork sheets with sufficient pressure to accomplish the desired result.

Relative movement is naturally effected between the brushes and the sheets so that the whole sheets are brushed, and in a single operation or in successive operations both sides of each sheet are brushed. Oppositely rotating brushes are used for maximum effectiveness in brushing all of the edges of the meshwork openings, although this feature is not specified in any of the claims in suit. Some but not all of the claims call for relative movement between the brushes and the meshwork substantially parallel

to the long dimension of the meshwork openings, so petitioner's brief (p. 19) contradicts the patent in saying the brushing *must* be done in that direction.

Petitioner admits (Br. p. 17) that brushes suitable for this work date back at least to 1868. Its expert also admitted that the Cross patent lies in the old scratch brushing art (Rec. p. 107). The primary features of organization of the Cross patent machine are fully disclosed in the prior art, as for example in the Buckman patents of 1891 (Def. Exs. 558, 559, Rec. pp. 2397, 2403, offered p. 459). Each of these patents shows two oppositely rotating brushes located on each side of the path of travel of sheets through the machine, exactly as is shown in the patent in suit. Petitioner states (Br. pp. 21, 31) that the Buckman patents "teach no more than the application of scouring powder to the surfaces of solid (imperforate) plate metal" and *makes no reference at all to the brushes*. The fact is that the brushes are the primary elements of the Buckman machines and the scouring powder is used merely to supplement or enhance the action thereof.

All that is involved in the patent in suit, therefore, is the use of brushing machines of the prior art to operate upon expanded metal, which differs only in *form* from the materials specifically referred to in the prior art. The suitability of wire brushes for treating material having irregular surfaces is a matter of common knowledge, as illustrated, for example, by the Broderick patent of 1907, which refers specifically to the advantage of using oppositely rotating brushes as follows:

"* * * By this arrangement all parts of all surfaces, whether flat, depressed or raised, are reached by the bristles or wires and thoroughly scoured or bur-nished." (Rec. p. 2446, lines 4-7, Def. Ex. 563, offered p. 459.)

There is ample evidence that the brushing machines of the prior patent art would satisfactorily perform the function of the Cross machine (Rec. pp. 469, 474-6, 479-90, 1114-6, etc.). Beyond this, however, the operability of two actual prior use brushing machines was demonstrated by *inter partes* tests preliminary to the trial of this case. The specimens of expanded metal brushed in the course of these tests stand unquestioned as "commercially practical products" (Rec. pp. 697-9, 2839, 2994).

Contrary to petitioner's contentions, the machines were adjusted and operated for these tests in a perfectly normal manner, by the workmen who regularly ran them (Rec. pp. 849-52, 931, 950). Petitioner concedes (Br. p. 21) that these machines have been in public use by The American Brass Co. since many years prior to the application for the patent in suit. The evidence clearly shows that while the said machines were never used commercially for the brushing of material in the specific form of expanded metal, they were regularly used to brush sheared metal sheets having burrs and sharp edges thereon, which were satisfactorily removed by the brushes (Rec. pp. 828-9, 845-6, 921-2, 938-9, 945).

Another point upon which clarification of the statement of facts is needed is that of development of the alleged invention by The Manufacturers Brush Co. rather than by the patentee, Cross. Petitioner claims for the patentee the benefits of the Brush Co. development (Pet. & Br. pp. 5-6, 11, 22-4, 31-3), but all it did to instigate such development was to write a letter, through its purchasing agent, telling the Brush Co. simply—

"What we are interested in knowing is whether the sharp edges can be removed with the wire brush, and if so, we would appreciate your returning the samples with the sharp edges removed, and also quoting us on

the equipment necessary to do this work." (Pl. Ex. 254(2), Rec. pp. 2121-2, offered p. 1749.)

No instructions or suggestions were given by Cross or petitioner to the Brush Co. as to what kind of brushes should be used, how the brushing should be done, or anything else.

In response to the above-quoted general inquiry the Brush Co. replied in a short time—

"It is with pleasure we advise you that these sharp edges can be removed with one of our 15" diameter, #415 Samson Wheel Brushes and we are returning the samples, thoroughly cleaned, under separate cover this mail." (Pl. Ex. 254(4), Rec. p. 2123, offered p. 1749.)

These samples were not produced at the trial, although called for by respondent (Rec. p. 1850), but the evidence as well as the inference is clear that they were at least reasonably well smoothed (Rec. pp. 1719-20, 1790-91). No subsequent improvement could have been anything more than in slight degree.

Another letter from the Brush Co. to petitioner (Pl. Ex. 254(5), Rec. pp. 2124-5, offered p. 1749), following very shortly after the above, gave detailed recommendations as to a commercial brushing machine design, including type and size of brush, speed and power requirements, etc., none of which was substantially departed from in petitioner's ultimate commercial machine (Def. Ex. 556, Rec. p. 2391, offered p. 457).

Petitioner's "insistent demand" argument is made in the face of the fact that *it was over five years later before its brushed expanded metal was put on the market*, and at best only two years of that time is accounted for by Cross's alleged further improvements (Rec. pp. 189, 1731-2). The

brushed material, when it finally did come out, was put on the market at no increase in price despite the higher cost of manufacture, and thereafter prices were actually reduced and sales volume was lower for the next several years (Rec. pp. 727, 188).

Any significance to the allegations that the brushed product eliminated serious conditions of injury to workmen, etc., is negated by the fact that there is no substantial evidence of such conditions ever existing. The Underwriters Laboratories' records in connection with its inspection service of petitioner's prior material over a long period of years show no complaints whatsoever, and there were only a very few such complaints in connection with the material of respondent's predecessor (Rec. pp. 312-4, 364-5, 909). Petitioner's general sales manager, in announcing the brushed product in 1931, said:

“ * * * 90% of our present customers are well satisfied with the mesh that we have been furnishing them.”
(Def. Ex. 550, Rec. p. 2385, offered p. 202.)

Its vice-president testified that petitioner never had any complaints that the unbrushed material did not come up to the claims of its literature alleging a high degree of smoothness of that material, and one of its salesmen who was called by petitioner to testify could not recall any rejections of such material (Rec. pp. 213, 225).

Lest the references in the petition (p. 8) to holdings of “insistent demand” be mistaken for quotations from the Court of Appeals' decision, it should be noted that they are isolated statements from the Master's report. The Master summed up his views in this connection as follows (Rec. p. 2893):

“Yet, as I see it, the evidence as a whole rather indicates that the metal being supplied was fairly satisfactory and met the demands of the trade, * * *”

Further showing the speciousness of the "insistent demand" argument is the fact that petitioner has disclaimed claim 15 of the Cross patent (Rec. p. 2936). This claim purported to cover "smooth" expanded metal without reference to any process of smoothing (Rec. p. 15). Claim 16, still in issue, is identical therewith except that it defines the product as "*brushed* smooth." There is no evidence, and no conceivable basis for any claim, that "brushed" smoothness is any different from any other kind of smoothness, or that there was ever any demand for brushed expanded metal as distinguished from material made smooth in any other way.

The real reason for the delay in the adoption of brushing as a regular commercial practice was the cost factor. While, as petitioner admits, brushes capable of doing the work had long been known in the art, the brush cost was prohibitive. Brush manufacturers ultimately developed brushes of special analysis steel bristles which wore so much more slowly that brush cost was reduced to permissible limits, and regular commercial brushing was begun shortly afterwards by both parties (Rec. pp. 1821-5, 1919-21, 1925, 688-9). It is not even contended by petitioner that Cross had anything to do with the development of such brushes, and the patent in suit neither discloses nor claims any details thereof.

In this connection, however, it is asserted in the petition (p. 10) that respondent, before the issuance of the Cross patent, secured "information from the manufacturer who had supplied vital parts of petitioner's machine." This is a rank misstatement. It is definitely refuted by petitioner's own witness on the point, an official of the brush company in question. It happened that respondent bought its brushes from the same manufacturer as petitioner had, but there is not a scrap of evidence that respondent even knew that

petitioner was brushing its expanded metal at that time, to say nothing of trying to locate the source of supply of petitioner's brushes. The above-mentioned witness specifically denied that respondent ever sought from his company any information as to petitioner's operations and that his company ever gave respondent any information whatsoever as to the machine or operations of the petitioner. He stated unequivocally that they knew nothing whatever about petitioner's machine (Rec. pp. 405-6).

In any event it is peculiar, to say the least, for petitioner to claim that respondent got information about "vital parts" of petitioner's machine, when the most that such "vital parts" could involve would be the brushes themselves, which petitioner flatly admits (Br. p. 17) were very old in the art.

As to the "open and adverse possession" of the alleged invention referred to in the petition (pp. 9-10) respondent's own development and use prior to the issuance of the patent in suit is a factor of strength rather than weakness in its position. The record clearly shows that when respondent was charged with infringement after issuance of the patent it promptly asserted the defense of invalidity (Rec. pp. 27-8).

Diversity of Opinions Below Is Not Significant.

Of the three opinions below only the three-page Memorandum of the District Court (Rec. pp. 2924-7) was favorable to petitioner. This proposed to overthrow the painstaking work of the Special Master, whose report finding all of the involved patent claims invalid covers pages 2809-2902 of the record. The District Court decision purported to have been based upon "authoritative patent decisions," but it is significant that *it cited no authorities at all*. Moreover, it was based upon a serious misconception of the facts of

the case, for it referred to The American Brass Co. machines as being used *to prepare material for galvanizing* and not to remove danger of injury in handling (Rec. p. 2925). Actually these machines were always employed to remove dangerous burrs and sharp edges (Rec. pp. 828-9, 845-6, 921-2, 938-9, 945). They never had anything to do with the preparation of any material for galvanizing, and there is nothing in the record that even suggests such an idea. In reality, the record shows a situation quite the reverse of that assumed by the District Judge, for it is an admitted practice of *petitioner* to brush some of its expanded metal preparatory to galvanizing the same (Rec. pp. 220, 1850). All told, the District Court decision is neither tenable on its face nor consistent with the record.

The Court of Appeals decision, on the other hand, contains an accurate and thorough discussion of the facts and issues involved and decides those issues with specific reference to controlling authorities (Rec. pp. 2989-98). It is in accord with every one of the Master's recommendations adverse to the patent and in addition sustains the defense of invalidity of claim 16 as not patentably distinct from disclaimed claim 15 (Rec. p. 2996). The petition does not even attempt to demonstrate any error in the sustaining of this further defense.

The situation is well summed up in the words of the Master, quoted with approval by the Court of Appeals (Rec. p. 2993), that "The brush couldn't help itself doing what it (did)," and in the further comment by the Court of Appeals (Rec. p. 2997) that failure to determine just how the brushing should be done "would characterize as dull even an otherwise highly skilled artisan."

On this record it is submitted that the diversity between the ultimate conclusions of the District Judge on the one hand and those of the Special Master and the Court of Ap-

peals on the other does not create a situation requiring review by this Court.

No Concentration of the Industry in the Sixth Circuit.

It is asserted in the petition (p. 7) that the industry is concentrated in the Sixth Circuit, citing the affidavit of Lewis McC. Steenrod filed therewith. Respondent takes direct issue with this assertion and with the averments of the affidavit upon which it is predicated, submitting in refutation an affidavit of William L. Keady, respondent's president, which is reproduced as an appendix to this brief.

As shown by the Keady affidavit, there are several manufacturers of expanded metal in the United States who are subject to patent infringement suits in many, if not all, of the circuits other than the Sixth, by reason of the location of either their manufacturing plants or the states of their incorporation, or by reason of their doing business in various states throughout the country. These additional circuits having such jurisdiction include at least the Third (Milcor Steel Co. and National Gypsum Co., both Delaware corporations); the Fifth (Alabama Metal Lath Co., manufacturing at Birmingham, Alabama); the Seventh (Ceco Steel Products Co., manufacturing at Chicago, Illinois, and Milcor Steel Co., manufacturing at Milwaukee, Wisconsin); the Eighth (Ceco Steel Products Co., a Nebraska corporation); and the Ninth (Truscon Steel Co., manufacturing at Los Angeles, California, as well as at Youngstown, Ohio). In addition, these manufacturers as well as others located in the Sixth Circuit are subject to suit in the many jurisdictions in which they are doing business (see *Neirbo Co. v. Bethlehem Corp.*, 308 U. S. 165), and their distributors and dealers are likewise subject to suit throughout the country.

Petitioner's allegations in this regard are based upon an attempted classification of expanded metal which is not only completely untenable in itself, as the Keady affidavit shows, but the propriety of which is disproved upon the face of the very patent in suit. The Steenrod affidavit (p. 13) purports to exclude "expanded metal which is used for reinforcement purposes such as reinforcement of concrete and plaster" from the types of material with which the patent is concerned. Reference to the patent will show that *both expanded metal lath and expanded metal for use as concrete reinforcement are specifically named as subject to treatment according to the alleged invention*, the concrete reinforcement type being mentioned, in fact, as a particularly outstanding example (Rec. p. 11, lines 9, 55-6, 58-69).

The patent is absolutely unlimited as to the types of expanded metal with which it is concerned. Indeed, it states that it applies to expanded fabrics *of all kinds*. Elimination of injuries to workmen *handling and installing* such fabrics is emphasized fully as much as, if not more than, elimination of injuries resulting from contact with material which is exposed in use, and this of course applies equally to reinforcing material and any other expanded fabrics (Rec. p. 11, lines 70-78).

Thus, even the allegations of *fact* made by petitioner in this connection are disproved.

Petitioner's authorities, *Mackay Co. v. Radio Corp.*, 306 U. S. 86, and *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47, are also inapplicable because in each of those cases the patents were *sustained* by the Court of Appeals, so that the plaintiff had no incentive to sue in other circuits. Here, however, the question is whether petitioner *could* bring suit elsewhere if it so desired, and it has been shown very definitely that it could.

**Court of Appeals Decision Not Based on Misinterpretation
of Schriber-Schroth Decisions.**

Aside from the above-mentioned points, petitioner's case is primarily based upon the premise that the Court of Appeals, in the case at bar, "misunderstood," "misapplied" and "misinterpreted" the decisions of this Court in *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47 and 311 U. S. 211 (see Pet. & Br. pp. 7, 9, 10, 25-7). Such a position is beyond understanding, for the only reference to these authorities in the Court of Appeals decision is at the very end thereof (Rec. p. 2998) where they are merely mentioned in connection with that Court's own decisions in the same cases and the statement that

" * * * commercial success alone or the apparent solution of a long perceived problem will not of itself vitalize an otherwise invalid patent."

Surely petitioner cannot contend that such a holding is in any way erroneous. The decision of this Court in *Thropp's Sons Co. v. Seiberling*, 264 U. S. 320, 330, for example, is to the same effect. This rule is so well established and so clearly a salutary one that the citation of other authorities should be wholly unnecessary.

No other mention of any *Schriber-Schroth* case appears in the Court of Appeals decision herein except at page 2994 of the record, and there it is only *its own* decisions (*Cleveland Trust Co. v. Schriber-Schroth Co.*, 92 F. (2d) 330 and 108 F. (2d) 109) that the Court has reference to. This discussion follows a definite holding of lack of invention in the patent in suit and is actually nothing more than *obiter*. In any event, the discussion of these cases is only on the side of greater leniency toward petitioner's case, because the substance of it is that even if the patent in suit were measured by the more liberal standards applied by the

Court of Appeals in the *Schriber-Schroth* cases it would still have to be held invalid for want of invention. By no stretch of the imagination can this holding be twisted into an erroneous interpretation or application of this Court's decisions, as petitioner urges.

Moreover, the Court below indicates (Rec. p. 2994) a more liberal view on the question of invention than that set forth by the Court of Appeals for the Second Circuit in *Picard v. United Aircraft Corp.*, 128 F. (2d) 632 (certiorari denied . . . U. S. . . . 87 L. Ed. 38). Here again, therefore, it is clear that the Court of Appeals has by no means applied the most rigorous standards of invention in invalidating the patent in suit.

In this same connection petitioner complains (Br. p. 26) that the Court of Appeals failed to apply the authority of *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464, saying:

"* * * Although not adverting to the *Paramount* case by name, the Court of Appeals considered the argument and rejected it, primarily because of the decisions of this Court in the *Schriber-Schroth* cases,"

This statement is directly contrary to fact, for the Court of Appeals squarely predicated its decision upon the *Paramount* case, specifically citing the same, thus (Rec. p. 2993):

"* * * the prompt recognition by the Supreme Court in *Paramount Corp. v. Tri-Ergon Corp.*, 294 U. S. 464, that sound film patents but applied the skill and wisdom of photography, should put a period to the fanciful distinction here asserted."

Also cited in support of this holding were the decision of this Court in *Cuno Corp. v. Automatic Devices Corp.*, 314 U. S. 84, 91 and 92, and several decisions of the Court below, and the inapplicability of the most favorable case cited

by petitioner on the point involved, *Lakewood Engineering Co. v. Walker*, 23 F. (2d) 623, was clearly demonstrated.

The fact is, therefore, that the Court of Appeals decided this case in reliance upon the very authority which petitioner now asserts was not even adverted to by name in the decision, specifically distinguishing the principal other authorities relied upon by petitioner, and without even mentioning the *Schriber-Schroth* decisions of this Court except in reference to the elementary proposition that commercial success alone cannot sustain a patent. Since the *Schriber-Schroth* decisions played no substantial part in determining the Court of Appeals' views in the case at bar, it is manifest that petitioner's allegations of misinterpretation and misapplication of those authorities are utterly without foundation.

No Failure to Apply This Court's Decisions.

The respective subdivisions of petitioner's contentions in this regard are answered as follows:

(a) (Pet. & Br. pp. 8-9, 27-9.) It has been demonstrated *supra* that petitioner is in error both in contending that the Court of Appeals decision herein was predicated upon a misinterpretation of this Court's decisions in the *Schriber-Schroth* cases and in denying that the Court of Appeals followed or even made any reference to the *Paramount* case, 294 U. S. 464.

Expanded Metal Co. v. Bradford, 214 U. S. 366, is no authority for the proposition that the filing of a long-felt want will sustain a patent except in a doubtful case. It is clear that the Court of Appeals had no doubt as to the invalidity of the patent here in suit, and in view of the authorities already cited herein the patent could not be sustained upon the instant contentions of petitioner even if such contentions were well founded in fact.

It is further stated by petitioner (Br. p. 28) that the decision of the Court of Appeals is not based upon the testimony of any witness that what Cross did was within the expected skill of the art. On the contrary, there is ample testimony to that effect (Rec. pp. 100, 105, 118, 161, 470, 471, 482, 1117).

(b) (Pet. & Br. pp. 9-10, 29-30.) This Court's decision in *Krementz v. The S. Cottle Company*, 148 U. S. 556, is urged by petitioner as applicable because of a statement made by the president of respondent's predecessor in the case at bar. In the case cited, however, it was emphasized that the prior attempt and failure to solve the problem were *by a highly skilled artisan*. There is no such evidence in the present case, and in fact the contrary appears (Rec. p. 571). Moreover, it is apparent from the context of the statements cited by petitioner that the factor of *cost* played an important part in the appraisal of the situation (Pl. Ex. 23, Rec. p. 1973, offered p. 308). The author of those statements died long before the trial of this case (Rec. p. 306), so respondent had no opportunity to get any further elucidation from him.

(c) (Pet. & Br. pp. 10, 30-31.) The authority of *Hobbs v. Beach*, 180 U. S. 383, has no bearing as insisted by petitioner, because it involved the changing of a machine so as to make it perform *a wholly different function*. It is difficult to see how petitioner can seriously contend that the removal of burrs and sharp edges from expanded metal is in anywise a different function from the removal of burrs and sharp edges from other sheared metal sheets, which has been definitely shown (*ante*, p. 4) to be one of the functions of the prior use machines of The American Brass Co. and also a function which the Buckman patent machines would be readily capable of performing. It will be remembered that the Buckman machines are *brushing* machines

embodying the same brush arrangement as the Cross patent, rather than merely machines for applying scouring powder as represented by petitioner.

The most that can be said for the patent here in suit is that it is applied to the treatment of the same material in a *form* somewhat different from the specific references of the prior art, without producing any new character of result. This is obviously not inventive. *Cuno Corp. v. Automatic Devices Corp.*, 314 U. S. 84, 91, and cases cited; *Concrete Appliances Co. v. Gomery*, 269 U. S. 177, 184; *Howe Machine Co. v. National Needle Co.*, 134 U. S. 388, 397-8.

(d) (Pet. & Br. pp. 10, 31-3.) The cases cited by petitioner in support of its contention that Cross was entitled to the benefits of the work done by The Manufacturers Brush Co. are clearly inapplicable because the Brush Co. did its work without the benefit of any instructions or suggestions from Cross (see *ante*, pp. 4-5). In *Agawam Co. v. Jordan*, 7 Wall. 583, 602, only "discoveries ancillary to the plan and preconceived design of the employer" were held to redound to the latter's benefit. The record at bar is clear that there was no such "plan and preconceived design" in this case. The situation in *Minerals Separation, Limited v. Hyde*, 242 U. S. 261, was even more remote, the Court saying (p. 270):

"* * * The record shows very clearly that the patentees planned the experiments in progress when the discovery was made; that they directed the investigations day by day, conducting them in large part personally and that they interpreted the results."

Moreover, the *Agawam* case contains a positive holding fatal to petitioner's case, as follows (7 Wall., at p. 603):

"* * * But where the suggestions go to make up a complete and perfect machine, embracing the substance of all that is embodied in the patent subse-

quently issued to the party to whom the suggestions were made, the patent is invalid, because the real invention or discovery belonged to another."

As previously pointed out (*ante*, p. 5), the recommendations of The Manufacturers Brush Co. to petitioner actually embodied the essential features and details of the machine and operation upon which is based the patent subsequently taken out in the name of Cross.

No Conflict with Decisions of Other Circuits.

There is likewise no substance to the claims advanced in the petition to the effect that the Court of Appeals decision herein is in conflict with the decisions of other Circuit Courts of Appeals. Again answering petitioner's contentions in corresponding subdivisions, respondent submits:

(a) (Pet. p. 10.) Nothing is involved here but another reiteration of petitioner's contentions referring to the *Paramount* and *Schriber-Schroth* cases. Those contentions have already been fully answered herein.

(b) (Pet. p. 11.) Reference to the decision in *Leibing Automotive Devices, Inc. v. Wildermuth*, 104 F. (2d) 411, 412 (C. C. A. 2), will show that there is no rule in the Second Circuit such as that urged by petitioner on citation of *Kurtz v. Belle Hat Lining Co.*, 280 Fed. 277. Going still further, see *Picard v. United Aircraft Corp.*, 128 F. (2d) 632, 636.

(c) (Pet. p. 11.) *White v. Converse*, 20 F. (2d) 311, and *Traitel v. Hungerford*, 18 F. (2d) 66, utterly fail to establish any Second Circuit rule that adaptations need not involve any invention to sustain a patent. *White v. Converse* makes no specific reference to invention or lack of invention in the adaptations themselves and simply purports to follow *Traitel v. Hungerford*, which held that a

patent might be supported on the basis of slight structural changes *only when such changes presuppose a use not discoverable without inventive imagination*. In the case at bar the Court of Appeals has held (Rec. p. 2992) that the adaptation required in the case of the Buckman patents "would have consisted merely of adjustments quite obviously within the skill of the art" and (p. 2993) that the allegation of new use is "but a play upon words" as well as being inconsistent with the admissions of petitioner's expert, and accordingly found no invention in the subject matter in issue. Certainly there is nothing in this holding inconsistent with the Second Circuit cases cited by petitioner.

Moreover, the same rule was very clearly stated in *Hobart Mfg. Co. v. Landers, Frary & Clark*, 26 F. Supp. 198, 202 (D. C.), affirmed on opinion below, 107 F. (2d) 1016 (C. C. A. 2), and it is plain from the recent decision in *Picard v. United Aircraft Corp.*, *supra*, that the Second Circuit now applies a much more stringent test.

The petition further cites *Rousso v. City Towel Supply Co.*, 242 Fed. 655, as setting forth "the rule in the Seventh Circuit." This was not a Seventh Circuit case at all and was not even a Court of Appeals decision. It was a decision of the District Court for the Southern District of California. Even so, it did not hold as petitioner represents. It said nothing about adaptations not inventive in themselves, but rather sustained the patent only on the basis of *substantial* changes.

(d) (Pet. p. 11.) Two cited decisions of the Court of Appeals for the District of Columbia are alleged by petitioner to support its claim that Cross was entitled to the benefit of the work done by The Manufacturers Brush Co. One of these is *Massey et al. v. Ridge*, 270 Fed. 879, which was an interference proceeding in which the party Ridge

had disclosed the invention to the opposing party. The Court held that Ridge had a *complete conception* of the invention prior to his discussion of it with Massey et al. and accordingly held that he was entitled to the patent. *Orcutt v. McDonald*, 27 App. D. C. 228, the other of the cases cited by petitioner, applied precisely the rule of *Agawam Co. v. Jordan*, already discussed herein (*ante*, p. 16). Clearly, these authorities have no applicability in the case at bar, where it definitely appears that no conception of the alleged invention was transmitted by Cross to The Manufacturers Brush Co.

Element of Public Importance Entirely Lacking.

In view of the foregoing demonstration that the decision of the Court of Appeals in no wise misinterprets or fails to apply the applicable decisions of this Court or conflicts with decisions of other Circuit Courts of Appeals, and that there is no concentration of the involved industry in the Sixth Circuit, this case cannot assume the proportions of public importance urged in the petition (pp. 11-12).

The controlling issue in the case is that of invention, which was urged by petitioner below to be a question of *fact*, to be determined according to the evidence, citing *Thomson Spot Welder Co. v. Ford Motor Co.*, 265 U. S. 445, and *Eibel Process Co. v. Paper Co.*, 261 U. S. 45. Manifestly such an issue is not a matter of public importance, particularly when, as here, the Court of Appeals and the Special Master have found alike with respect to it on the basis of the most carefully considered opinions, and the only contrary opinion is that of the District Court which fails to cite any authorities or to state any substantial reasons in support of its conclusion.

Conclusion.

It has been shown herein that the petition at bar is ill founded in both law and fact. The only question that could be resolved by this Court is that of validity of the patent in suit, hinging upon the question of invention. This cannot involve any important issue of general patent law, and in such circumstances there is no ground for issuance of the writ of certiorari. *Keller v. Adams-Campbell Co.*, 264 U. S. 314, 319; *Layne & Bowler Corp. v. Western Well Works*, 261 U. S. 387, 393. Accordingly, the petition should be denied.

Respectfully submitted,

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